

REMARKS

Claims 1-34 are pending in the present application. No amendments to the claims are made by this Response. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 102, Alleged Anticipation, Claims 1-34

The Office Action rejects claims 1-34 under 35 U.S.C. § 102(e) as being allegedly anticipated by Cooper et al. (US 2001/0051996 A1). Because this rejection is essentially the same as in the previous Office Action, this rejection is respectfully traversed for the same reasons stated in the previous Response filed October 9, 2003, the remarks of which are hereby incorporated by reference. The following remarks are provided in rebuttal of the Examiner's statements in the present Office Action beginning on page 2, section 2 of the Final Office Action.

In the October 9, 2003 Response, Applicants argued that the Cooper reference does not teach, with respect to claim 1, which is representative of the other rejected independent claims 11, 12, 14 and 24, receiving a request to remove selected information from the stored information from a user within the set of users, wherein the selected information is received in response to a transaction involving the user. In response, the Examiner, on page 2 of the present Office Action states the following:

In the Telephone interview of 10/17/03 and in the Response, Applicants attempt to draw distinction between revoke and remove. Firstly, there is no evidence in the Disclosure that the removal of data from memory means anything other than the usual removal of access, which would allow garbage collection processes to reclaim the memory space. Secondly, Webster's New Riverside University Dictionary, Houghton Mifflin Company, ©1984, 1988, defines revoke as meaning to nullify by withdrawing, recalling or reversing. There is no obligation of the revoking authority to re-instate, and thus revocation is equivalent to removal.

Applicants correctly states that patentability depends on each and every element of a claim, but then argues claims 2-7 in terms of element 2, whereas claims 3-7 depend directly on claim 1 and do not include that element. (The arguments concerning claims 8-26 are included in this analysis.) New claims 27-34 are addresses below.

As to claim 1, Applicant states [page 11] that Cooper does not teach receiving a request to remove selected information, received from a user in response to a transaction involving the user. To reiterate the rejection, Cooper is directed to transactions in which a user, who obtains a digital certificate which allows access to content selected by the user. [See also 0018; 0060 lines 6-9.] Of course this is done by some management system, but so are the steps of the claims, and a user request is required to trigger the process. As noted at [0065], any entity may act as the certification authority that revokes a user's digital certificate [0069]. Again, such an act cannot be arbitrary, but inherently must be initiated by request, which is itself a transaction in the system.

Applicant respectfully disagrees that Applicants' disclosure contains no evidence that the removal of data from memory means anything other than the usual removal of access. To the contrary, throughout the present description it is stated that the present invention's whole intent is to provide a user with the ability to "remove" their personal or confidential information from a server. For example, this is referred to on page 4, lines 12-18; page 12, lines 25-28; page 20, lines 7-10 and elsewhere. One example section of the present specification that provides support for removal of selected information is found at least on page 14, lines 6-18 of the specification, which reads as follows:

A user may identify personal or confidential information sent to server 400 through security process 414. A request may be generated and sent to server 400 to remove this information. The request is received by Web server 406 and sent to security process 412 for handling. If the information is no longer required for a particular transaction, security process 412 removes the information from client information database 410. A confirmation is then returned to the user at client 402, indicating that the information has been removed. If the information is still required for the transaction, such a notice is returned to the user.

This section of the Applicants' specification provides adequate disclosure that a user identifies personal or confidential information that is intended for removal, a request is received to remove the information and, if the information is no longer required, the information is removed from the client information database. The whole reason for the present invention is to remove information from a server so that it is no longer accessible by the server. This is clear from the many sections of the disclosure referenced above and many other portions of the disclosure that are not explicitly pointed to above. The only way in which information may be removed from a server, so that it is no longer

accessible by the server, is to completely remove the information, such as by completely deleting this information from the server. Simply "revoking" information does not achieve this purpose.

In determining the scope of a term in the claims, the Examiner must look to both the intrinsic evidence provided in the disclosure and may, when the intrinsic evidence is considered not sufficient, consider extrinsic evidence provided by other sources. As discussed above, the intrinsic provided when reading the claims in view of the specification makes it clear that the term "remove" means to completely delete or "get rid of" the information so that it is no longer accessible by in the stored information. This is clear from page 20, lines 7-10, which state that the particular mechanism of the present invention is used for "removing traces of personal or confidential information, such as a credit card number or a social security number." Removing traces of personal or confidential information means to completely remove or delete this information so that it is not accessible by the server. Simply "revoking" information would not remove all traces of personal or confidential information. In fact, "revoking" leaves the information but revokes the ability to use the information. Thus, traces of the personal or confidential information are still present when the information is simply "revoked."

Moreover, other sections of the specification make it clear that the complete removal so that there is no accessibility to the information is intended by the term "remove." For example, Figure 11 and page 19, lines 14-17 state that "removal of the confidential information from the database may not occur if the confidential information is still required for the transaction." It is clear from this statement that if the information is removed, the server would not be able to complete the transaction because the information is no longer present. If the information were simply "revoked", the transaction could complete and then the information not be used again but still be present in the server. Therefore, again "removal" is not the same as "revoking."

Thus, the intrinsic evidence found within the disclosure clearly points to the term "revoke" meaning to completely remove or delete so that the information is no longer present in the stored information. Moreover, Applicants' own arguments have limited the definition of the term "remove" to have this definition and to not include simply

"revoking" the information. Therefore, the Examiner should interpret the term "remove" in the manner asserted by Applicants.

However, if the intrinsic evidence and Applicants' arguments are not considered to be sufficient, the extrinsic evidence also points to the term "remove" being different and non-synonymous with "revoke." The term "remove" is defined by Webster's Dictionary, Random House Inc., ©1996, 1993 as meaning "to do away with" or "eliminate." The Examiner's provided definition of "revoke" is contrary to the definition of "remove". The Examiner states that the definition of the term "revoke" is "to nullify by withdrawing, recalling or reversing" as per Webster's New Riverside University Dictionary, Houghton Mifflin Company, ©1984, 1988. It is conspicuous that the Examiner's own definition of "revoke" does not mention "removing" and the term "remove" is not identified by Webster's as a synonym of "revoke." This is because "nullifying" is not the same as "removing." The term "nullify" means to invalidate, not to completely remove or delete so that there is no trace of the information left, as with the term "remove." Furthermore, Applicants respectfully submit that neither "revoke" nor "remove" are synonyms of each other as per Roget's II, The New Thesaurus, Houghton Mifflin Company, © 1980.

Moreover, Applicants respectfully disagree with the Examiner's statement that "There is no obligation of the revoking authority to re-instate, and thus revocation is equivalent to removal." Nowhere in Cooper is it taught that revocation of a user's digital certificate is equivalent to removal. To the contrary, Cooper teaches that the digital certificate must be retained for further investigation at paragraph [0148], which reads as follows:

[0148] For this reason, other security precautions may be taken. The CPS may additionally contain a password that must be correctly matched by the legitimate consumer at the time the hardware device containing the digital certificate logs on to the VPN. If an attempt to enter the password fails more than a predetermined number of times, the digital certificate may be immediately revoked by the Authenticate User and Get Digital Certificate step 320 until a further investigation may be conducted. (emphasis added)

This section of Cooper teaches that if an invalid password is entered too many times the digital certificate is revoked until a further investigation may be conducted. If

Cooper were to teach as the Examiner alleges, "revocation is equivalent to removal", then Cooper would not be able to investigate the invalid use of the password tied to the digital certificate as it would no longer exist. Thus, Cooper does not teach removal of client information from the client information database in response to a request from a user, which identifies personal or confidential information that is intended for removal.

Furthermore, the revocation of the digital certificate as taught by Cooper is in response to an invalid password being entered is not a request from a user to remove selected information from the stored information of a user in response to a transaction involving the user. The revocation of the digital certificate is not an intended request to remove information about the user. Additionally, as shown above, if the entry of an invalid password were intended to remove information about the user, the teachings of Cooper would not perform the desired function. That is, the use of an invalid password by the user would result in the user no longer being able to access the information, but the information about the user is still in the stored information of the Cooper system.

Thus, in view of the above, Applicants respectfully submit that Cooper does not teach each and every feature of independent claims 1, 11, 12, 14 and 24 as is required under 35 U.S.C. § 102(e). As independent claims 8, 13, 21 and 25 recites features similar to those in claims 1, 11, 12, 14 and 24, Applicants respectfully submit that Cooper does not teach each and every feature of independent claims 8, 13, 21 and 25 as is required under 35 U.S.C. § 102(e). At least by virtue of their dependency on claims 1, 8, 14, 21 and 25, respectively, Cooper does not teach each and every feature of dependent claims 2-7, 9, 10, 15-20, 22, 23 and 16-34. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-34 under 35 U.S.C. § 102(e).

Additionally, in regard to the dependent claims, in the previous Response dated October 9, 2003, Applicants submit that claim 2 was argued as an example of the other dependent claims 3-7. As stated in the previous response:

For example, with regard to claims 2, Cooper does not teach determining whether the request is a valid request and preventing removing of the selected information in response to a determination that the request is an invalid request. (emphasis added)

To further exemplify that Cooper does not teach the features of claims 2-7, claim 3 recites that at least one of a certificate, a password, and a key is used to determine whether the request, which is a request to remove selected information from the stored information from a user within the set of users, is valid. As shown above, Cooper teaches away from removing information about a user and instead revokes the user's access to the information. Thus, Cooper does not teach validating a request to remove selected information from stored information based on at least one of a certificate, a password, and a key.

As a further example, claim 7 recites the request sent to the user is in a form of an applet requesting personal information about the user. The Examiner stated on the previous Office Action dated July 11, 2003 that "Cooper is intended to be used with the Internet, which typically applies applets within the Java language." Simply using the Cooper system with the Internet does not necessitate the use of applets. There are many server functions that are performed without using applets. For example, servlets may be used, HTML based forms, or a plurality of other tools may be used. Thus, simply stating that the Cooper system is "intended to be used with the Internet" does not sufficiently address the feature of an applet being used to request personal information about a user.

Furthermore, as stated in the previous Response, the Examiner fails to address the specific features of claims 8-13, 21-23 and 25-26, and merely alleges, without any supported evidence, that these claims are rejected on the same basis as claims 1-7, even though they contain additional features. For example, claim 8 contains the feature of sending a Web page to a user at a client. Nowhere in the Final Office Action or the Office Action dated July 7, 2003, does the Examiner provide a specific section of the Cooper reference that teaches this feature.

Additionally, the Final Office Action alleges that the feature of the request to remove selected information originates from a client device of the user, as recited in claims 27, 29, 31 and 33 is taught at paragraph [0058] and [0065]. As shown above, Cooper does not teach receiving a request to remove selected information from the stored information from a user within the set of users and instead revokes the user's access to the system in response to a user inputting the wrong password. As to dependent claims

28, 30, 32 and 34, they are dependent on independent claims 1, 8, 14 and 21, respectively, and overcome Cooper for the reasons shown above.

Furthermore, Cooper does not provide any teaching, suggestion, or incentive to make the needed changes to reach the presently claimed invention. Cooper actually teaches away from the presently claimed invention because this cited reference teaches retaining all information regarding the user and simply revoking access to the information, opposed to receiving a request to remove selected information from the stored information from a user within the set of users, where the selected information is received in response to a transaction involving the user and responsive to receiving the request, and removing the selected information from the stored information, as in the presently claimed invention. Absent the Examiner pointing out some teaching or incentive to implement Cooper to receive a request to remove selected information from the stored information from a user within the set of users, where the selected information is received in response to a transaction involving the user and responsive to receiving the request, removing the selected information from the stored information as in the presently claimed invention, one of ordinary skill in the art would not be led to modify Cooper to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify Cooper in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the Applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

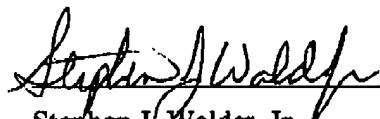
Thus, in view of the above, Applicants respectfully submit that Cooper does not teach each and every feature of independent claims 1, 8, 11-14, 21, 24 and 25 as is required under 35 U.S.C. § 102(e). At least by virtue of their dependency on claims 1, 8, 14, 21 and 25, respectively, Cooper does not teach each and every feature of dependent claims 2-7, 9, 10, 15-20, 22, 23 and 16-34. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-34 under 35 U.S.C. § 102(e).

II. Conclusion

It is respectfully urged that the subject application is patentable over Cooper and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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Attachments:

Webster's Dictionary, page 561
Random House Inc., ©1996, 1993

Roget's II, The New Thesaurus, pages 376 and 386
Houghton Mifflin Company, © 1980

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